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EXAMINER
PHAM, THOMAS K

ART UNIT	PAPER NUMBER
2121	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/827,011	SANKURATRIPATI ET AL.
	Examiner	Art Unit
	Thomas K. Pham	2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 March 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21,23 and 26-34* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21,23 and 26-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Response to Amendment

1.   This action is in response to the amendment filed on 03/27/2006.

2.   Applicant's arguments with respect to claims 1-21, 23 and 26-34 have been considered

but are moot in view of the new ground(s) of rejection.

Quotations of U.S. Code Title 35

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim Rejections - 35 USC § 103

7.	Claims 1-2, 8, 12-14 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent No. 5,948,061 ("Merriman") in view of U.S. Patent No. 6,836,799 ("Philyaw").

Regarding claim 1

Merriman teaches an advertisement selection and delivery system for selecting advertisements

based on profile information and rendering the advertisements as accessible to a user operating a

network-capable appliance connected to a data-packet-network comprising:

-	a first server node connected to the network, the first server node functioning as a user

	access point on the network (fig. 1, element 12 and col. 4 lines 16-19, "The affiliates may

	be ISP's ... single computer with a browser");

-	a mass storage repository accessible to the first server node (fig. 2, element 54), the

	repository for storing the user activity data and serving user profile data accumulated, at

	least, by accessing the stored user activity (col. 4 lines 44-55);

-	a second server node connected to the network, the second server node for generating

	user preference data (fig. 1, element 19);

-	at least one advertisement server connected to the network, the advertisement server for

	serving advertisement data (fig. 1, element 18);

-	a software application for generating user preference lists and performing advertisement

	selection (col. 5 lines 50-63, "the ad server 19 obtains ... location of their domain"); and

-	at least one network-capable appliance connected to the network, the network-capable

	appliance for receiving the advertisement data, wherein a user operating the network-

	capable appliance accesses the first server node and receives the advertisement data, the

advertisement data selected for service by matching the user profile data to stored advertisements and rendered accessible to the user during the time of user access to the system from the network-capable appliance (col. 3 lines 25-63, "on a computer or PDA or other Internet capable ... the advertising web server").

Merriman does not specifically disclose an instance of software residing on the first server capable of recording any user data-packet-network navigation activity data routed through the first server including, at least, transaction activity occurring at any destination Web sites the user freely chooses to navigate to.

However, Philyaw teaches a tracking software residing on a user PC (i.e. first server) for tracking (recording) any data-packet-network activity of the user (see abstract and Col. 3 lines 16-26) including, at least, transaction activity occurring at any web site servers on a global communication network (Internet or the World Wide Web) the user freely chooses to navigate to (see FIG. 25-26 and Col. 26 lines 1-56) for the purpose of tracking the user's efforts and interests as he or she visits the various web sites on the global communication network.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the network activity tracking of Philyaw with the system of Merriman because it would provide for the purpose of tracking the user's efforts and interests as he or she visits the various web sites on the global communication network (see Col. 25 lines 47-51).

Regarding claim 2

Merriman teaches the data-packet-network is the Internet network (abstract).

Regarding claim 8

Merriman teaches the first server node is a cobranded server node servicing clients of a cobrand partner to the entity hosting the system (col. 4 lines 13-19, "the affiliate web sites ... single computer with a browser").

Regarding claim 12

Merriman teaches the network-capable appliance accesses the system is a PDA. (col. 3 lines 25-30, "PDA or other Internet capable ... using the same protocol"). It is inherent to one of ordinary skill in the art that PDAs are capable of connecting wirelessly to a network.

Regarding claim 13

Merriman teaches the preference lists are generated using a knowledge base data system (col. 8 lines 35-46, "the number of viewings ... the display of the advertisements").

Regarding claim 14

Merriman teaches the preference lists are used as search criteria in conjunction with a search engine (col. 5 line 64 to col. 6 line 11, "Each advertisement along with ... a match should be selected").

Regarding claim 23

Merriman teaches a method for dynamically serving advertisement data based on user profile information to a user interface maintained on the Internet comprising the steps of:

a) compiling and storing the user profile information on an ongoing basis (col. 7 lines 46-56, "In addition, as part of the ... include the domain name") by monitoring any user navigation behavior on the Internet (col. 8 lines 33-41, "The reporting process uses ... by users of affiliate web sites" [the number of viewings and click throughs of various web pages are all part of the navigation behavior of a user on a network]);

b) accessing the user profile information in order to mine the information (col. 5 lines 50-63, "the ad server 19 obtains ... the location of their domain");

c) mining the accessed user profile information for preference data (col. 5 line 64 to col. 6 line 11, "Each advertisement along with ... a match should be selected");

d) formulating the preference data into a concise summary-data list (col. 3 lines 52-63, "Upon receiving the request ... the advertising web server");

e) selecting pre-configured advertisements from a database containing stored advertisements, the selection accomplished by matching the advertisements to data contained in the summary-data list (col. 6 lines 12-26, "determining which advertising object ... transmitting back to the user"); and

f) serving the selected advertisements to the user interface (col. 3 lines 25-30, "on a computer or PDA or other Internet capable ... using the same protocol").

Although Merriman teaches monitoring the user navigation behavior on a data-packet-network, Merriman does not specifically disclose the monitoring detail including transaction activity occurring at any destination Web sites the user freely chooses to navigate to.

However, Philyaw teaches a tracking software residing on a user PC (i.e. first server) for tracking (recording) any data-packet-network activity of the user (see abstract and Col. 3 lines 16-26) including, at least, transaction activity occurring at any web site servers on a global communication network (Internet or the World Wide Web) the user freely chooses to navigate to (see FIG. 25-26 and Col. 26 lines 1-56) for the purpose of tracking the user's efforts and interests as he or she visits the various web sites on the global communication network.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the network activity tracking of Philyaw with the system of Merriman

because it would provide for the purpose of tracking the user's efforts and interests as he or she

visits the various web sites on the global communication network (see Col. 25 lines 47-51).

Regarding claim 24

Merriman   teaches   the   data-packet-network   is   the   Internet   network   (abstract).

Regarding claim 26

Merriman teaches compilation of user profile information is augmented through manual data

procurement methods (col. 5 lines 47-49, "a promotional advertisement ... his or her employer").

Regarding claim 27

Merriman teaches steps (b)-(f) are performed as a sequence launched as a result of the profile the

user connecting to an accessing the user interface using a network-capable appliance (col. 5 line

50 to col. 6 line 59, "the ad server 19 obtains ... stored in RAM in one or more messages").

Regarding claim 28

Merriman teaches data mining is accomplished through a parsing method (col. 7 lines 37-43, "a

click through may be ... the advertising server process 19").

8.   Claims 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent

No. 5,913,040 ("Rakavy") in view of U.S. Patent No. 6,393,407 ("Middleton").

Regarding claim 15

Rakavy teaches a preference-data generation server for generating preference data using data

mined from user profile data comprising:

- a data port for receiving user profile data (fig. 3, element 754);

- a data port for accessing a knowledge database (col. 9 lines 8-15, "The User Preference

   ... to the other processes"); and

- a software application for mining the user profile data and for generating preference

   summaries by equating the mined profile data to pre-established preference categories

   listed in the knowledge database (col. 9 line 63 to col. 10 line 8, "The Job Manager 720

   ... to a wider range of users");

- wherein the profile data is accumulated, at least, by monitoring user navigation behavior

   on the Internet (col. 3 lines 44-49, "The system monitors the user's ... made available to

   the advertisers" [the user's interaction, how many times accessing a web page or how

   user's response to an advertise are all part of the navigation behavior of a user]).

Although Rakavy teaches monitoring the user navigation behavior on a data-packet-network, Rakavy does not specifically disclose the monitoring detail including transaction activity occurring at any destination Web sites the user freely chooses to navigate to.

However, Philyaw teaches a tracking software residing on a user PC (i.e. first server) for tracking (recording) any data-packet-network activity of the user (see abstract and Col. 3 lines 16-26) including, at least, transaction activity occurring at any web site servers on a global communication network (Internet or the World Wide Web) the user freely chooses to navigate to (see FIG. 25-26 and Col. 26 lines 1-56) for the purpose of tracking the user's efforts and interests as he or she visits the various web sites on the global communication network.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the network activity tracking of Philyaw with the system of Rakavy

because it would provide for the purpose of tracking the user's efforts and interests as he or she

visits the various web sites on the global communication network (see Col. 25 lines 47-51).

Regarding claim 16

Rakavy teaches the preference summaries are generated in the form of categorized and

prioritized data lists (col. 9 line 63 to col. 10 line 8, "The Job Manager 720 ... to a wider range of

users").

Regarding claim 17

Rakavy teaches a data port for receiving pre-configured advertisement data (fig. 10, element

250); a data port for serving advertisement data (fig. 10, element 210); and a software application

for matching the advertisement data to individual ones of generated data lists and for selecting

the advertisement data most closely matching the generated data lists for service (col. 9 line 63 to

col. 10 line 8, "The Job Manager 720 ... to a wider range of users").

Regarding claim 18

Rakavy teaches the matching advertisement data is served to a network-access point established

on the Internet (col. 4 lines 39-45, "FIG. 1 shows an overall view ... nodes on the Network

700").

Regarding claim 19

Rakavy teaches the network-access point is a server node (col. 5 lines 8-19, "The Network 700 is

... which to communicate").

Regarding claim 20

Rakavy teaches a data port for serving the prioritized data lists (col. 9 line 63 to col. 10 line 8,

"The Job Manager 720 ... to a wider range of users").

Regarding claim 21

Rakavy teaches the prioritized data lists are served to at least one advertisement server operating

on a data-packet-network (col. 4 lines 39-45, "FIG. 1 shows an overall view ... nodes on the

Network 700").

9.   Claims 3 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Merriman in view of Philyaw and further in view of U.S. Patent 6,651,190 ("Worley").

Regarding claim 3

Merriman and Philyaw teach the first server node and the second server node are connected to

the internet but do not teach the nodes connecting to each other by a separate dedicated network

in addition to being connected to the Internet.

However, Worley discloses these features in figure 3 where the "dedicated network" for

connecting between the remote computer stations (130, 132) and the host computer is by dialing

directly using a direct cell connection (140) or a direct land line to the cell wireless modem

connection (not shown) in addition to connecting to via the Internet for communication with the

host computer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the communication of Worley with the system of Merriman because it

would provide to serve as a backup communication method in case the Internet connection is not

available or down.

Regarding claim 6

Merriman teaches the software application resides in whole and executes on the second server node and advertisement selection is performed by the second server node using advertisements delivered thereto from the at least one advertisement server (col. 3 lines 52-63, "Upon receiving the request ... the advertising web server").

Regarding claim 7

Merriman teaches the second server node also serves the selected advertisements (col. 3 line 64 to col. 4 line 11, "when the user clicks ... to redirect the user's browser").

10.   Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman in view of Philyaw and further in view of U.S. Patent No. 5,933,811 ("Angles").

Regarding claim 4

Merriman and Philyaw teach the advertisement selection and delivery system but do not teach the software application is distributed in part on the second server node and in part on the at least one advertisement server.

However, Angles teaches the software application is distributed in part on the content provider computer 14 (second server node) and in part on the at least one advertisement computer 18 (advertisement server) (col. 8 lines 35-65, "At start state 300 ... into a displayable page") for the purpose of separately processes the user requested web page at one server and the customized an advertisement at a different server which dedicated for the job.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the system of Angles with the system of Merriman because it would

provide for the purpose of separately processes the user requested web page at one server and the customized an advertisement at a different server which dedicated for the job.

Regarding claim 5

Angles teaches the part of the software application executing on a second server node directs generation of user preference lists and the part of the software application executing on the at least one advertisement server performs the advertisement selection according to a user preference lists obtained from the second server (col. 14 lines 19-50, "The demographic data ... content provider computer 14").

11.   Claims 9 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman in view of Philyaw and further in view of U.S. Patent 6,230,199 ("Ravashetti").

Regarding claims 9 and 34

Merriman and Philyaw teaches the advertisement selection and delivery system but do not teach the advertisements include e-mail messages. However, Ravashetti discloses typical advertisement messages including email communication (col. 2 lines 25-31) for the purpose of providing another option to communicate with a client over the network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the email communication of Ravashetti with the system of Merriman because it would provide for actively marketing products and services to a user of a client computer over a network.

12.   Claims 10-11 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman in view of Philyaw and further in view of U.S. Patent 6,665,715 ("Houri").

Regarding claims 10 and 33

Merriman and Middleton teach the advertisement selection and delivery system but do not teach the advertisements include instant messages.

However, Houri discloses an example of collecting user data using instant messaging environments (col. 8 lines 37-56) for the purpose of gathering geographic location information from the users for advertising preferences.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the instant messages of Houri with the system of Merriman because it would provide for the purpose of gathering geographic location information from the users for advertising preferences.

Regarding claim 11

Merriman teaches the advertisements include banner advertisements (col. 3 lines 30-34, "Those messages 22 preferably ... such as banner advertisement").

13.   Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman in view of Philyaw and further in view of Rakavy.

Regarding claim 29

Merriman and Philyaw teach the advertisement selection and delivery system but do not teach the preference data is categorized and prioritized according to pre-configured preference categories related to types of advertisements.

However, Rakavy teaches the preference data is categorized and prioritized according to the user interaction while responding to advertising messages (col. 3 lines 34-43, "Users may

enter their ... for on-line customers") for the purpose of matching the user preferences and configuration data against the category information for the available advertisement.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the categorizing and prioritizing of Rakavy with the system of Merriman because it would provide for the purpose of matching the user preferences and configuration data against the category information for the available advertisement.

Regarding claim 30

Rakavy teaches the summary-data list is of the form that can be propagated through the network (col. 7 lines 14-29, "Each Advertisement 50 in the ... by various Advertisements 50").

Regarding claim 31

Merriman teaches the summary-data list is sent to an advertisement server wherein the advertisement server performs steps (e) and (f) (col. 6 lines 12-26, "determining which advertising object ... transmitting back to the user").

Regarding claim 32

Rakavy teaches the Advertising System Server 600 is a single server node on the Network 700 (col. 4 lines 43-45, "Advertising System ... on the Network 700") that performed steps (c)-(f) (col. 3 lines 5-51, "downloading and presenting individualized advertisements ... WEB site on the network").

Response to Arguments

In the remark applicant argues that cited reference failed to disclose:

"transaction activity occurring at any destination Web sites the user free chooses to navigate to" as to claims 1, 15 and 23.

In response to applicant's arguments,

Prior art Philyaw (U.S. Patent No. 6,836,799) discloses a tracking software residing on a user PC (i.e. first server) for tracking (recording) any data-packet-network activity of the user (see abstract and Col. 3 lines 16-26) including, at least, transaction activity occurring at any web site servers on a global communication network (Internet or the World Wide Web) the user freely chooses to navigate to (see FIG. 25-26 and Col. 26 lines 1-56) for the purpose of tracking the user's efforts and interests as he or she visits the various web sites on the global communication network see Col. 25 lines 47-51.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (571) 272-3689, Monday to Thursday from 6:30 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (571) 272-3687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Pham
Patent Examiner

April 7, 2006